

REMARKS

Applicants would like to thank the Examiner for the careful consideration given to the present application. The present application currently has claims 25-31 pending. Claims 16-19 have been canceled, but it should be noted that claims 17-19 have merely changed their dependency and, for the Examiner's convenience, have been added as new claims 29-31. The application has been carefully reviewed in light of the Office Action. Applicants respectfully submit that the claims are patentable over the cited references for at least the reasons set forth below. Reconsideration of this application is hereby requested.

Objections

The Examiner has objected to the form used in canceling certain claims in the preliminary amendment. As such, Applicants have provided a copy of all of the currently pending claims, with current status identifiers to address the Examiner's objection.

Specification

The Examiner has objected to the abstract because it does not contain a proper description of the claimed invention. As such, Applicants have provided a replacement abstract with directions for its entry.

Claim Rejections – 35 U.S.C. 103

The Examiner has rejected claims 16, 18, and 19 under 35 U.S.C. 103(a). In light of Applicants cancellation of claims 16, 18, and 19, it is believed that this rejection is moot.

The Examiner has rejected claims 16-19, 25, and 28 under 35 U.S.C. 103(a) as being unpatentable over applicants admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Crosslen (U.S. Patent No. 4,265,038) and Teter et al. (U.S. Patent No. 6,112,665). In light of Applicants cancellation of claims 16-19, it is believed that this rejection,

as applied to claims 16-19, is moot. With respect to the rejection as applied to claims 25 and 28, Applicants traverse this rejection.

To establish a *prima facie* case of obviousness, one criterion that must be met is that there must be some suggestion or motivation to combine reference teachings. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner states that Applicants admitted prior art discloses the idea of placing paint chips in a rack, the idea of using paint chips with a plurality of colors on a single card and the idea of covering a paint chip with a single color. The Examiner further states that applicants prior art discussion does not disclose whether the display rack includes a wall that covers a chip section and the idea of placing perforations in the card to form a paint chip section. The Examiner has combined Applicants prior art statement with the teachings in Crosslen and Teter to make the instant rejection. Applicants do not believe that independent claim 25 is obvious in light of the cited references. Moreover, all of the claims depending from claim 25 also cannot be obvious, for at least the reason that claim 25 is not obvious.

First, Applicants believe that it is improper to combine Teter et al. with Applicants prior art discussion to arrive at a single-color color card that includes perforations to create a perforated chip section. Applicants respectfully submit that there is absolutely no suggestion or motivation to combine the two teachings that the Examiner has used to make the instant rejection. With respect to the Examiner's combination of Applicants prior art teaching and Teter et al., there is no suggestion in either reference, and more importantly, there is certainly no suggestion in Teter et al., to combine the references to arrive at placing perforations on a color card with a single color in order to form a detachable paint chip. Absent any suggestion or motivation to combine, it cannot be obvious to combine the references. Furthermore, the references actually teach away from any such combination.

The Teter et al. reference specifically and solely teaches the use of a color card with a plurality of color swatches. In fact, Teter et al. is the type of color card that Applicant has referenced as being undesirable – a conventional color card with a multitude of colors. The set of perforations within the colored area, as taught by Teter et al. are part of a larger swatch card of multiple colors. Teter et al. in no way suggests the use of perforations with a single-color color

card. Throughout the Teter et al. reference, there is mention that the color card includes many colors. Column 4, line 43 *et seq.* states that the stippling in Figs. 4 and 5, i.e., the same figures that the Examiner has used to make the instant rejection, is used to indicate different printed colors. Additionally, the Teter et al. reference is replete with references to more than one color used on the color card. In Col. 4, lines 48-50, of the Teter et al. reference, it is taught that the colors of the swatches may be related or totally independent from one another. There is no suggestion to include only a single color on the Teter et al. color card.

Applicants have specifically stated that there are many deficiencies with the use of conventional color cards that exhibit numerous colors (see Specification page 1, line 28 *et seq.*). One deficiency that Applicants have referenced is that the human eye tends to blend colors together when the colors are presented such as they are on a conventional color card of multiple colors. Additionally, the intensity that is imparted to a specific color is not as apparent on a conventional color card as would be on a larger surface, such as a single-color color card. Accordingly, there is no suggestion or motivation to combine a reference that teaches a multiple-color color card, such as Teter et al. with a teaching of a single-color color card.

Furthermore, the distinctions pointed out between single-color and multiple-color color cards, and Applicants teaching of the undesirability of using a multiple-color color card, in fact teach away from any combination of a single-color color card with a multiple-color color card reference.

The functionality of the single-color color card and the multiple-color color card is completely different and the teachings of the contrasting cards are not compatible for use with one another. Applicants prior art teaching, as discussed above, shows that a single-color card is not consistent with and is contrary to the purposes and functionality of a multiple-color color card insomuch that a multiple-color color card has many deficiencies that are addressed through the use of a single-color color card. As such, Applicants prior art teaching cannot properly be combined with Teter et al.

In addition to the above reasons for patentability of the instant claims, the Teter et al. reference does not contemplate that the color on the swatches are formulated to have a dried color that is substantially similar to dried color of a commercially available paint composition. The Teter et al. patent contemplates that the blank swatches are run through a color printer or photocopier to provide for a color on the swatches. There is no motivation to use Teter et al. to

exhibit colors similar to commercially available paint colors. In fact, the reference contemplates the ability to make swatches for colors that represent “spot” colors and textiles. Additionally, the swatches may be used to record the color samples that pertain to printing projects or advertising campaigns. Accordingly, there is no suggestion to combine the Teter et al. reference with the prior art teaching in Applicants specification, which discloses a single-color color card for the display of paint.

With respect to the combination of Crosslen with Applicants prior art discussion, the Examiner states that some of the chip sections would be covered by the walls of the display rack disclosed in Crosslen. Crosslen in no way contemplates the display of a single-color color card that includes perforations that define a chip section within the color card. Applicants claim 25 defines a “chip section” as that section which is defined by a perforations. Furthermore, claim 25 states that the “chip section” is covered by the wall of the display rack. The element of a wall that covered a “chip section” of a display rack is not present in the Crosslen reference. Furthermore, there is no teaching in Crosslen to show that the wall covers the chip section to prevent the chip section from being grabbed by a consumer.

There is also no motivation or suggestion in Crosslen to provide for a wall on a display rack so that the wall prevents a chip section from being grabbed. This is especially true because Crosslen does not contemplate the use of the display rack to display a color card with a perforated area that is movable. There is no motivation to combine the teachings in Teter et al. with that of the Crosslen reference. Teter et al. does not contemplate that the templates provided to be used with a printer or copier are intended to be displayed in any method other than in a fan deck. There is no suggestion to display the swatch cards of Teter et al. in a display rack such as that provided in Crosslen. Teter et al. expressly states that the swatch cards that can be created from the templates are displayed in a fan arrangement. In fact, the template provides for a hole (17) through which a fastener may be placed in order to create a fan deck. There is no teaching in Teter et al. that the templates are intended to be provided in a display rack. Moreover, Teter et al. provides that the templates are used by printers and graphic artists for printing projects and the like (Col. 1, line 32 *et seq.*). Unlike a store display of paint cards which, by its nature would require multiple cards of the same color scheme to be provided in stacks so that when one card is removed, an identical card comes into view, a printer or graphic artist would not have the need to

display numerous color cards of the same color scheme in a display rack. For at least the foregoing reasons, Teter et al. does not contemplate use of the templates in a display rack.

Moreover, Teter et al. contemplates that the blank swatches are run through a color printer or photocopier to provide for a color on the swatches. There is no motivation to use the templates of Teter et al. to exhibit colors similar to commercially available paint colors. Teter et al. also does not provide that the templates can be used as a paint color card.

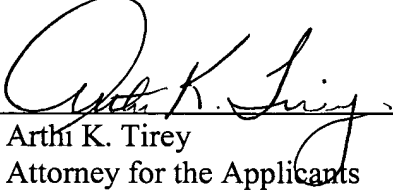
With respect to claim 28, Applicants also traverse this rejection. Applicants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 25. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There is no basis for an obviousness rejection of claim 28 in light of the failure of the references to provide any suggestion or motivation to be combined.

With respect to claims 26 and 27, Applicants traverse this rejection. As Applicants have stated above, Applicants prior art discussion, Teter et al. and Crosslen are not properly combinable because there is no suggestion or motivation to combine the references. As such, independent claim 25 is not obvious and claims 26 and 27, depending from claim 25, are also not obvious.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If the Examiner has any questions with respect to the foregoing, he is invited to contact the undersigned. Applicants would like to again thank the Examiner for his review of the subject application.

Respectfully submitted,

THE SHERWIN-WILLIAMS COMPANY

By: 
Arthi K. Tirey
Attorney for the Applicants
Reg. No. 50,960

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The Sherwin-Williams Company
11 Midland Bldg. - Legal Dept.
101 Prospect Avenue, N.W.
Cleveland, Ohio 44115
Phone: (216) 566-3650